UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,510	09/18/2001	Matthew A. Hayduk	884.552US1	9786

21186 7590 06/20/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938	RAMAKRISHNAIAH, MELUR	

ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	09/955,510	HAYDUK, MATTHEW A.
Office Action Summary	Examiner	Art Unit	
	Melur Ramakrishnaiah	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _17 February 2005_.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-27_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-27_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

2.   Claims 1-5, 8-12, 13-14, 16, 20, 22, 24, 25, are rejected under 35 U.S.C 102(e)

as being anticipated by Obradovich et al. (US PAT: 6,542,812, Provisional application

No. 60/160,326, filed on Oct. 19, 1999, hereinafter Obradovich).

Regarding claims 1, Obradovich discloses an application execution system,

comprising: a position monitoring module (119, fig. 1), a mobile element (120, fig. 1)

associated with a position capable of being monitored by the position monitoring module

(col. 3 lines 31-45, col. 4 lines 34-41), the mobile element having memory (108, fig. 1)

including a set of user service preferences including a first service preference (figs. 3-4,

col. 6, lines 8 –50).

Regarding claim 13, Obradovich discloses a mobile element, comprising: a

position monitoring module (119, fig. 1) capable of monitoring a position associated with

the mobile element (col. 4 lines 34-44), a first memory (108, fig. 1) including first service

preferences as shown in fig. 3, the memory capable of receiving second service

preferences determined by the position, and a comparator module (reads on processor

3) communicatively coupled to the memory to compare the first and second service preferences (col. 4, line 64 – col. 5, line 46, col. 8 lines 30-38).

Regarding claim 16, Obradovich discloses an apparatus, comprising: a processor (103, fig. 1), a memory (119, fig. 1) coupled to the processor for receiving a position and first service preferences (fig. 3) associated with the mobile elements, a memory coupled to the processor including a second service preference (figs. 3-4, col. 6, lines 8-50) associated with the position, and an application associated with the second service preference (col. 3 lines 31-45).

Regarding claim 20, Obradovich discloses a method of executing an application, comprising: determining a position of a mobile terminal (fig. 1), selecting a second service preference associated with an application according to the position and a first service preference retained in the mobile elements (figs. 3-4, col. 6, lines 8-50, col. 3 lines 31-45).

Regarding claim 25, Obradovich discloses computer readable medium having program instructions stored therein for implementing, when executed by a digital processing device, a method for executing an application, the method comprising: determining position of a mobile element, and selecting a second service preference associated with an application according to position and first service preference retained in the mobile element (col. 7 lines 3-41, col. 8 lines 30-59).

Regarding claims 2-5, 8-12, 14, 22, 24, Obradovich further teaches the following: position monitoring module includes a software program (implicit as the reference teaches GPS receiver 119 to determine position, fig. 1, col. 6 lines 36-42), comparator

module resides in service broadcaster (col. 8 lines 30-50), a global positioning system

receiver (119, fig. 1) communicatively coupled to the position monitoring module (col. 6

lines 34-44), mobile element includes memory (108, fig. 1), wherein the service

broadcaster includes an application associated with second service preference (col. 8,

line 30 – col. 9, line 55), mobile element is a cellular phone (col. 4 lines 34-44), second

service preference is a hotel list file (215, fig. 3), plurality of list files related to the set of

user preferences is broadcast to the mobile element (col. 8 lines 29-50), plurality of list

files is formatted as a selection list (fig. 8, figs 13-14), wherein selection list includes a

selected number of items determined by the position (col. 8 lines 34-38), storing the first

service preference in the mobile element (fig. 3), wherein second service preference is

hotel list file (215, fig. 3).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 6-7, 15, 17, 26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Obradovich in view of Rautila et al. (US PAT: 6,549,625, filed 6-24-

1999, hereinafter Rautila).

Obradovich differs from claims 6, 15, 17, 26 in that although he discloses

application required to browse information obtained based on user service preferences

and user profiles (col. 5 lines 1-33, col. 8 lines 29-50), he does not explicitly teach the following: downloading application to the memory for execution by the mobile element.

However, Rautila discloses method and system for connecting a mobile terminal to a database which teaches the following: downloading application to the memory for execution by the mobile element (col. 5 lines 30-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: downloading application to the memory for execution by the mobile element as this arrangement would provide one of the methods, among many possible methods, of providing application programs for the user to obtain information from servers as taught by Rautila

Regarding claim 7, Obradovich teaches the following: mobile element is a personal internet client (fig. 5 col. 7 lines 20-29).

5.   Claims 18-19, 23, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obradovich in view of Masaki (EP 0883270 A1).

Regarding claim 18-19, 23 and 27, Obradovich does not teach the following: a memory for receiving a set of capabilities associated with the mobile element, wherein the application is not downloaded to the mobile element if the set of capabilities associated with the mobile element is not in accordance with set of application requirements associated with the application, sending a set of capabilities associated with the mobile element to the service broadcaster.

However, Masaki discloses distributed computing system which teaches the following: to provide a distributed computing system capable of providing, in a network environment with various terminals, an application service corresponding to processing capability of each terminal, a memory in (12, fig. 1) for receiving a set of capabilities associated with the communication terminals (col. 3 lines 51-56, figs. 12-13, col. 25 lines 31-41, col. 26 lines 27-56).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: a memory for receiving a set of capabilities associated with the mobile element, wherein the application is not downloaded to the mobile element if the set of capabilities associated with the mobile element is not in accordance with set of application requirements associated with the application, sending a set of capabilities associated with the mobile element to the service broadcaster as this arrangement would facilitate data transmission based on capability of the communication terminals connected to the data transmission system as taught by Masaki.
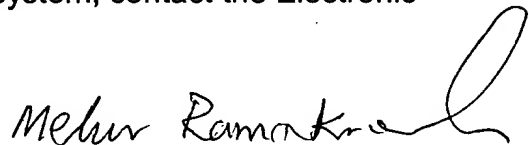
Response to Arguments

6.   Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Melur Ramakrishnaiah
Primary Examiner
Art Unit 2643